

## **REMARKS**

### **Pending Claims**

Claims 1-5, 8-9, 12-17, 19-21 and 25-35 are pending in the application. Claims 1-5, 8-9, 12-17, 19-21 and 25-33 have been amended. Claims 22-24 were canceled by prior amendment. Claims 6, 7, 10, 11 and 18 were withdrawn for being directed to a non-elected invention. Claims 6, 7, 10, 11 and 18 have been canceled without prejudice or disclaimer. New dependent claims 34 and 35 have been added. There are now 5 independent claims and 27 total claims pending. Claims 1, 9, 16, 25 and 31 are independent. The original filing fee covers the number of claims now pending.

### **Restriction/Election**

The Office Action mistakenly states that Applicants' election was without traverse. Applicants respectfully point out that the Response filed September 24, 2007, included a traversal of the Restriction Requirement and specifically preserved Applicants' rights to petition. Applicants' traversal also specifically preserves their right to rejoinder of the subject matter of claims 6, 7, 10, 11 and 18 upon allowance of the respective base claims. Claims 6, 7, 10, 11 and 18 have been canceled in light of their withdrawal due to the election.

**35 U.S.C. §§ 102 and 103**

Claims 1-5, 8, 9, 12-17, 19-21, 25, and 30-33 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Boarman et al., US Pat. No. 5,113,873 (hereafter "Boarman"). Claims 27 and 28 stand rejected under 35 U.S.C. § 103(a) as being unpatentable in view of Boarman. Claim 26 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Boarman in view of Alla et al., US Pat. No. 5,992,415 (hereafter "Alla"). Claim 29 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Boarman in view of Valentine, US Pat. No. 5,387,206 (hereafter "Valentine"). Applicants respectfully traverse these rejections, and request reconsideration and withdrawal of the rejections for the following reasons.

**Independent Claim 1 is Allowable**

Claim 1, as amended, includes the limitation that

...said pouch being constructed to reside in a contracted configuration when said condom is deployed in the vagina ... said contracted configuration serving to bias said open end of said pouch toward the anatomy of the female surrounding the vagina for retaining the condom within the vagina (emphasis added).

Thus, as discussed at, pages 3-4 of Applicants' specification, the prior art female condoms, such as is illustrated in FIG. 1, have a problem in which the open end of the condom tends to sag out of the user's vagina. This can result in a number of problems, such as blocked entry, false entry, fluid leakage, and the like. Under the invention set forth in claim 1, however, the contracted configuration of the pouch

biases the open end of the condom toward the anatomy of the female surrounding the vagina, thereby retaining the condom within the vagina and preventing the condom from sagging out of the vagina. Boarman and the other art of record provide no teaching or suggestion of a condom as set forth in claim 1 that resides in a contracted configuration for biasing the open end of the condom toward the body of the female. Instead, Boarman teaches a tubular member that is a full length condom, and that does exist in a contracted configuration when deployed.

Claim 1 further includes the limitation of

...said pouch further being able to resiliently extend longitudinally from said contracted configuration to an elongated configuration when a penis is inserted into said condom, and said pouch including a longitudinal biasing means for returning said pouch to said contracted configuration following removal of the penis.

According to this aspect of Claim 1, the pouch is able to resiliently extend longitudinally from a contracted configuration to an elongated configuration when a penis is inserted into the condom during sexual intercourse. Then, as the penis is withdrawn, a longitudinal biasing means is configured to return the pouch to the contracted configuration. Thus, under Applicants' invention, the pouch extends when a penis is inserted during intercourse, and the pouch contracts back to the contracted configuration as the penis is withdrawn. Boarman fails to teach or suggest a female condom having such a structure. Instead, Boarman teaches that tubular container 50 is used to insert the tubular member 12 into the user's vagina,

and the tubular member 12 and the container 50 therein are longitudinally displaced a predetermined distance, as determined by the length of the tubular member 12 within the vaginal cavity (see col. 4, lines 34-42). Thus, Boarman's pouch is placed into the vagina a predetermined length, and is not configured to reside in a contracted configuration that is able to be resiliently extended to an elongated configuration by insertion of a penis and then return to the contracted configuration upon withdrawal, as set forth in Claim 1. In Boarman, the female condom has a full-length pouch that does not extend and contract with insertion and removal of the penis during intercourse. Accordingly, Applicants respectfully assert that claim 1 is allowable over Boarman and the other art of record, whether taken singly, or in combination.

**Independent Claims 9 and 16 are Allowable**

As amended, independent claim 9 includes

...wherein said pouch is longitudinally biased into a contracted configuration following deployment of said condom in the vagina, said contracted configuration biasing said frame into contact with the female anatomy surrounding the vagina....

Thus, claim 9 sets forth a female condom having a pouch that is longitudinally biased into a contracted configuration following deployment in the vagina, which biases the frame into contact with the female anatomy surrounding the vagina. As discussed above with respect to claim 1, Boarman fails to teach or suggest this aspect of Applicants' invention.

Additionally, amended independent claim 9 includes

...wherein said pouch is constructed of a highly elastic material having a structure that allows said pouch to elastically extend longitudinally to an extended configuration caused by insertion of the penis into the pouch during sexual intercourse, and wherein said highly elastic material exerts a contractive longitudinal bias for returning said pouch toward said contracted configuration during each withdrawal of the penis during sexual intercourse (emphasis added).

This limitation of claim 9 specifies that the structure of the pouch allows the pouch to extend longitudinally to an extended configuration caused by insertion of the penis, and then exerts a contractive longitudinal bias for returning the pouch toward the contracted configuration during withdrawal of the penis. Boarman fails to teach or suggest a pouch having a structure in which the pouch is deployed in a contracted configuration, is able to elastically extend longitudinally to an extended configuration due to insertion of the penis into the pouch, and then exert a contractive longitudinal bias for returning the pouch toward the contracted configuration, as recited in Applicants' claim 9. Instead, Boarman teaches that tubular container 50 is used to insert the tubular member 12 into the user's vagina, and the tubular member 12 and the container 50 therein are longitudinally displaced a predetermined distance, as determined by the length of the tubular member 12 within the vaginal cavity (see col. 4, lines 34-42 of Boarman). Thus, Boarman's pouch is placed into the vagina a predetermined length, and not configured to exist in a contracted configuration or elastically extend longitudinally to an extended configuration due to insertion of the

penis into the pouch during sexual intercourse. Accordingly, Applicants respectfully submit that claim 9 is allowable over Boarman and the other art of record. Independent claim 16 includes limitations similar to those discussed above for claim 9, and is allowable under a similar rationale.

**Independent Claim 25 is Allowable**

As amended, independent claim 25 includes limitations similar to those discussed above with respect to claims 9 and 16. Accordingly, Applicants respectfully submit that claim 25 is allowable for same reasons as set forth above for claims 9 and 16.

In addition, claim 25 includes

...said sponge being positioned to contact a head of the penis inserted into said condom during sexual intercourse, whereby the combination of the resiliency of the pouch wall and compression of the sponge enable extension and contraction of the condom with insertion and withdrawal, respectively, of the penis during sexual intercourse, such that an amount of compression of the sponge reduces an amount of extension of the pouch required for accommodating the penis into the pouch (emphasis added).

Thus, according to this aspect, the sponge compresses while the pouch stretches due to contact with the head of the penis during intercourse, such that an amount of compression of the sponge reduces an amount of extension of the pouch required for accommodating the penis into the pouch. In Boarman, on the other hand, the sponge is maintained for absorbing liquids, and is not positioned in a contracted

pouch that would result in contact of the sponge with the head of the penis during intercourse or any substantial compression of the sponge. Accordingly, claim 25 is allowable over Boarman and the other art of record for this aspect as well.

Furthermore, dependent claims 27 and 28 specify that the thickness of the sponge is substantially larger than any sponge taught by the prior art for achieving this aspect of Applicants' invention. The ranges set forth in claims 27 and 28 are well outside any ranges for thickness of a sponge taught or suggested by Boarman or the other art of record, and therefore are not within the workable ranges that would be discoverable through routine experimentation. Until Applicants' disclosure, sponge thickness was not considered in the art to be a result-effective variable. Before the determination of optimum ranges of a parameter can be characterized as "routine experimentation" by the Examiner, the particular parameter must first be recognized in the art as a result-effective variable, i.e., a variable which achieves a recognized result. *In re Antonie*, 559 F.2d 618, 195 USPQ 6 (CCPA 1977). Accordingly, as the prior art does not recognize sponge thickness as a result effective variable, Applicants' claimed range and structure cannot be deemed obvious as routine experimentation.

**Independent Claim 31 and Dependent Claims 2, 20 and 30 are Allowable**

Independent claim 31 includes limitations similar to those discussed above with respect to claims 9 and 16. Accordingly, Applicants respectfully submit that claim 31 is allowable for the same reasons.

In addition, independent claim 31 includes

...wherein, in said contracted configuration, said pouch is an average length of a normal vaginal canal, and in said elongated configuration, said pouch is configured to repeatedly extend up to the length of the vaginal canal, as extended by insertion of the penis during intercourse, and then spring back toward the contracted configuration during withdrawal of the penis.

As discussed in Applicants' specification, for example, at page 13, a normal vaginal canal length is two to three inches, but penetration by a penis at the time of intercourse can increase the length of the vaginal canal to six or seven inches, depending on the anatomy of the sexual organs of the partners. Thus, Applicants' claimed pouch in the contracted configuration is substantially shorter than any other female condom taught by the references of record (e.g., typically less than half the length of the prior art). Conventional female condoms, such as Boarman, are designed to be of sufficient length to accommodate a fully inserted penis. Thus, the prior art fails to teach a female condom having a contracted configuration that is the average length of a normal vaginal canal and an elongated configuration in which the pouch is configured to repeatedly extend to the length of the vaginal canal, as



extended by insertion of the penis. Accordingly, Applicants respectfully assert that claim 31 is also patentable over the art of record for this aspect.

Further, as Applicants' much shorter pouch length achieves the unexpected result of preventing the condom from sagging out of the vagina, it would not be obvious to implement the ranges set forth in Applicant's claims through routine skill or optimization. In particular, before the determination of optimum ranges of a parameter can be characterized as "routine experimentation" by the Examiner, the particular parameter must first be recognized in the art as a result-effective variable, i.e., a variable which achieves a recognized result. *In re Antonie*, 559 F.2d 618, 195 USPQ 6 (CCPA 1977). In the present case, limiting the length of a pouch to a contracted length of 2-3 inches when deployed in the vagina has not, until Applicants' disclosure, been recognized in the art to be a result-effective variable. Accordingly, Applicants respectfully submit that claim 31 is allowable for this aspect as well. Dependent claims 2, 20 and 30 include similar limitations, and are allowable under a similar rationale.

**Dependent Claims 15, 19, 34 and 35 are Allowable**

New dependent claim 34 includes

...wherein said contracted configuration of said pouch is less than three inches from the open end to the closed end,  
wherein said pouch is configured to extend to more than five inches due to insertion of the penis during intercourse to reach said elongated configuration, and

wherein said biasing means of said pouch causes said pouch to retract back toward the contracted configuration of less three inches during withdrawal of the penis.

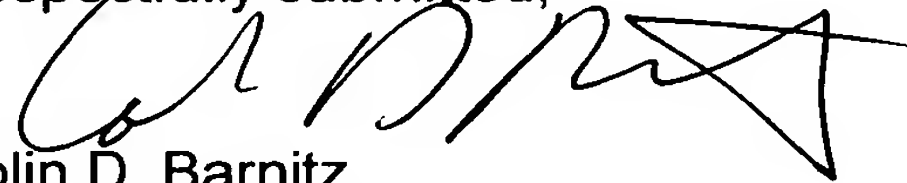
Thus, claim 34 specifies that the length of the contracted configuration is less than three inches, which is a substantially shorter length than any prior art female condom. As discussed above, Applicants' much shorter pouch length achieves the unexpected result of preventing the condom from sagging out of the vagina. Because of this, it would not be obvious to implement the ranges set forth in Applicant's claims through routine skill or optimization. As discussed above, before the determination of optimum ranges of a parameter can be characterized as "routine experimentation" by the Examiner, the particular parameter must first be recognized in the art as a result-effective variable, i.e., a variable which achieves a recognized result. *In re Antonie*, 559 F.2d 618, 195 USPQ 6 (CCPA 1977). In the present case, limiting the length of a pouch to a contracted length of less than three inches when deployed in the vagina has not, until Applicants' disclosure, been recognized in the art to be a result-effective variable. Accordingly, Applicants respectfully submit that dependent claim 34 is allowable for this aspect. Dependent claims 15, 19 and 35 include similar limitations and are allowable under a similar rationale.

The remaining claims not discussed above are directed to additional patentable features of the invention, and are allowable at least because they depend from an allowable base claim.

**Conclusion**

Should the Examiner feel that additionally discussion of the invention or the prior art would be useful, the Examiner is encouraged to contact the undersigned via telephone. In view of the foregoing, Applicants respectfully request that a timely Notice of Allowance be issued in this case.

Respectfully submitted,



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